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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,104	08/22/2001	Natalie Bryant	007051.P008	9322
23446 7590 12/18/2007 MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO, IL 60661			EXAMINER SHAH, MILAP	
			ART UNIT 3714	PAPER NUMBER
			MAIL DATE 12/18/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/935,104

Applicant(s)

BRYANT, NATALIE

Examiner

Milap Shah

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-5 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-5 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 31, 2007 has been entered.

The Examiner acknowledges that claim 2 was amended, claims 1 & 6-8 were canceled, and claim 9 was added. Therefore, claims 2-5 and 9 are currently pending.

### *Claim Objections*

Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 2 recites the display is a video display simulating reels, which is already recited in claim 9, from which claim 2 depends.

Claim 4 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 4 depends from claim 3, in which claim recites that each of the reels has a set of symbols having more than one occurrence of the scatter symbol, where more than one occurrence is considered the same as reciting "at least two" scatter symbols in the set of symbols for each reel, which

is recited in claim 4. Essentially claim 4 appears to recite the same limitation as that of claim 3 using different wording.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-5 & 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoseloff et al. (U.S. Patent No. 6,471,208).

**Claims 2 & 9:** Yoseloff et al. disclose the invention substantially as claimed including a gaming machine for playing a spinning reel game in which a player wagers a bet on the outcome of the game, comprising:

a video display arranged to display a simulation of spinning reels, each of the reels carrying a plurality of symbols, the symbols carried by each reel including a plurality of standard symbols and one or more scatter symbols, the video display being configured to display at least three symbols for each reel when the reels are in rest condition (column 3, line 59 – column 4, line 2);

a wager selector in which a player selects the wager to be made on the outcome of a game played on the machine, the wager selector being adapted to accept wagers by a player for one or more of a plurality of pay lines on the display (column 4, lines 19-35; note: players place a wager, which must be placed via a “wager selector”, on the randomly occurring event, such as

a video slot simulation game having nine pay lines as shown in figure 1A; see also figure 2[coin slot 14]); and

a game control arranged to cause the reels to spin and then come to rest, thereby defining a game outcome and (1) if a predetermined combination of standard symbols occur on a pay line on which the player has wagered a bet, or (2) if a predetermined number of scatter symbols occur anywhere on the display, the machine awards a prize defined by a pay table (column 4, line 66 – column 5, line 19; where reference to specific or normal symbols are the standard symbols and reference to “trigger symbols” that initiate a scatter pay are scatter symbols).

Yoseloff et al. lack an explicit discussion or disclosure of the arrangement of symbols on the reels, such as the arrangement that each reel has at least one scatter symbol and at least one reel has at least a pair of scatter symbols separated from each other on the reel by no more than one standard symbol. Yoseloff et al. do disclose that all the displayed scatter symbols contribute to the total number of scatter symbols on the display for at least the purpose of triggering a scatter pay or bonus event (column 4, lines 51-59).

Thus, the only remaining difference between Yoseloff et al. and the instant claims appear to be the specific arrangement of at least two scatter symbols on at least one reel, in which the scatter symbols may be separated from each other by no more than one standard symbol. Arrangement of indicia on reels is considered an obvious matter of design choice to those skilled in the art. Granted, pay tables and resulting potential combinations are evaluated before any specific arrangement is actually used commercially. Yoseloff et al. provide numerous disclosure throughout that would motivate one skilled in the art to modify any particular existing reel having a set of symbols including only one scatter symbol of Yoseloff et al. (note: it

is not confirmed that Yoseloff et al. use the particular arrangement of only one scatter symbol per reel, but it is the minimum arrangement necessary to provide the triggering events discussed within Yoseloff et al, however, Yoseloff et al. may very well have more than one scatter symbol on a reel, but Yoseloff et al. make no explicit disclosure either way) with at least two scatter symbols on a single reel not separated by more than one standard symbol.

Yoseloff et al. disclose:

“Each virtual reel contains a predetermined symbol set, and appearing according to a predetermined frequency of occurrence. Examples of symbols that can be used are cherries, plus, watermelon, other fruit, and specialty symbols. The preferred specialty symbols include a ‘whammy’, in the form of an animated devil that serves as the trigger symbol for the bonus feature. Preferably, the whammy symbol must appear in three locations on the screen display to trigger the second or bonus segment” (column 4, lines 31-37, emphasis added).

“Preferably, the occurrence of a minimum number of single predefined ‘trigger’ symbols appearing anywhere on the screen display pays a payout as a scatter pay and also triggers the bonus event” (column 3, line 66 – column 4, line 2, emphasis added).

“Trigger symbols may be used in sets of 1, 2, 3, or more trigger symbols appearing on the screen or in view of all the pay lines to initiate 1, 2, 3, or more specific events or awards” (column 7, lines 32-34, emphasis added).

Thus, as can be seen from at least these three excerpts above, Yoseloff et al. clearly do not preclude an arrangement that at least two scatter symbols are capable of being displayed on the display screen in a single reel, where the two scatter symbols are separated by at most one standard symbol. Yoseloff et al. require at least three trigger symbols *anywhere* on the screen, and using the arrangement discussed, the gaming machine of Yoseloff et al. would maintain its operation by triggering scatter pays or bonus events in the same way, such as when one of five reels displays two scatter symbols and at least one other reels displays at least one scatter symbol.

Therefore, such an arrangement would have been an obvious variant to what was disclosed by Yoseloff et al. and in view of Yoseloff et al's teachings, those skilled in the art would have had the common knowledge and skill in the art to modify Yoseloff et al. with various arrangements of symbol sets, at least based on the fact that Yoseloff et al. does not limit the gaming machine to any particular symbol set. Further, those skilled would have been able to predict which arrangements were most beneficial based on various pay table and expected return calculations. Thus, the Examiner submits that to those skilled in the art, it would have been obvious to try such an arrangement, where such an arrangement would have yielded expected or predictable results. Those skilled in the art have good reason to pursue known options (i.e. the option to add or remove various types of symbols from a reel's symbol set) within his or her technical grasp and if this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.

**Claims 3-5:** In view of the rationale discussed above, those skilled in the art would have good reason to pursue a multitude various arrangements that may lead to an anticipated success. Other arrangements that constitute obvious variants of the above discussed arrangement include the set of symbols for each reel having at least two scatter symbols, such that each reel may have up to 3 scatter symbols adjacent to each other so that each reel is capable of displaying the 3 scatter symbols at the same time, resulting in 15 scatter symbols displayed (i.e. a extremely good outcome for the player). Therefore, those of ordinary skill in the art would have good reason to pursue these additional obvious variants of the arrangement disclosed above and if this leads to an anticipated success, it is likely the product is not of innovation but of ordinary skill and common sense. Therefore, it would have been prima facie obvious to modify Yoseloff et al. to obtain the specific arrangement discussed in any of claims 3-5.

*Response to Arguments*

Applicant's arguments filed October 31, 2007 have been fully considered but they are not persuasive. The response to arguments is included in the updated rejections above. The rejection relies on Yoseloff et al. as previously discussed and updated above.

The Applicant also argues the fundamentals of the difference between ordinary or standard symbols and scatter symbols. The Examiner agrees as to their fundamental difference when pay tables, return percentage, and expected return calculations are taken into account. However, for mere arrangement of indicia on a reel, the Examiner disagrees that the fundamentals of these types of symbols are that different. Clearly any arrangement of these two types of symbols would require those of ordinary skill in the art to perform necessary calculations to determine if such an arrangement would be commercially acceptable, however, none of this precludes the fact that these arrangements are possible and are obvious variants of any other arrangement that is possible. Thus, the Examiner does appreciate that various arrangements may allow for winning combinations having a greater number of scatter symbols, however, the Examiner disagrees that such somehow makes an arrangement that is clearly an obvious variant, non-obvious.

For at least these and other reasons within the updated rejection, claims 2-5 & 9 are rejected.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milap Shah whose telephone number is (571) 272-1723. The examiner can normally be reached on M-F: 9:30AM-6:00PM.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Robert Pezzuto  
Supervisory Patent Examiner  
Art Unit 3714

/MBS/